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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,259	08/09/2001	Jonathan William Adams	AUS920010647US1	4214

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EXAMINER

NGUYEN, TAN D

ART UNIT	PAPER NUMBER
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3629

MAIL DATE	DELIVERY MODE
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06/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/925,259	Applicant(s) ADAMS ET AL.	
	Examiner Tan Dean D. Nguyen	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The amendment filed 1/9/07 has been entered. Claims 1-9 are pending. Claims 1-8 are method claim. Claim 9 is a system claim. Claims 10-20 have been canceled.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 9 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As of 1/9/07, claim 9 is as followed:

9. (Original) A system for designing an architecture for an e-business solution, said system comprising:

(a) means for developing a business description of the e-business solution, the business description describing each actor and each business function in the e-business solution, the business description further describing each interaction among one or more actors and one or more business functions;

(b) means for developing a pictorial representation of the business description; means for establishing one or more business patterns that are identifiable within the pictorial representation, each business pattern being indicative of each grouping of one

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or more actors and one or more business functions based on a nature of the interaction among the one or more actors and the one or more business functions;

(c) means for establishing one or more integration patterns that are identifiable within the pictorial representation, each integration pattern being indicative of an integration of two or more business patterns;

(d) means for establishing one or more composite patterns that are identifiable within the pictorial representation, each composite pattern being indicative of a grouping of a recurring combination of one or more business patterns and one or more integration patterns; and

(e) means for establishing one or more application patterns that are identifiable within the pictorial representation, each application pattern being indicative of a partitioning of an application logic and a data together with the styles of interaction among a plurality of logical tiers.

Claim 9 appears merely to be a program or software. There is no citation of a processor / computer and memory configured to store an application that includes instructions which, when executed by the processor, cause the processor to perform operations for carrying out the steps as shown in steps/means (a)-(e) above. The “means for” language is noted, but there is no citation in the specification to define what it is or what element or devices it’s replacing or being equivalent to and therefore, it’s not qualified to be used as 112, 6th paragraph, means-plus-function element. Moreover, the means for can be interpreted as “program/module for developing a business

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description". From page 18 of the specification, it appears that features (a)-(e) above are part of the "architecture design program 171 for implementing flowchart 10 (Fig. 1)).

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.**

The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, without undue experimentation. The claim fails to include at least one example, or demonstration to show how the method of claim 1 or 9 works. For example, what and how steps (a) or (b) or (c) are carried out and how (c.) is carried out to fulfill the scope of the claim which is "designing an architecture for an e-business solution". Can applicant cite an example or summary of the logic of how claim 1? The examiner has read the specification at least twice and has no clear understanding of what are the claimed invention. The examiner has give this case to another examiner who has a degree in MIS and an MBA and this examiner has the same problem. The specification merely explains the language of the claims but contains no examples of how the inventions work as a whole from steps (a) to (c.).

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The examiner has read the applicant's arguments of July 12, 2006, however, it's not persuasive. Tables 1, 2 and 3 "DRIVERS" AND "DRIVER TYPE" have been reviewed several times there are nothing in here talking about how to derive a "design a flow or diagram for a business solution"? Applicant's comments on pages 17-18 have been reviewed but they are merely applicant's opinions and nothing concrete of how to connect all of these description to come up with a simple example of carrying out the language of method claim 1 of design a business solution or wherein the last step of the claim, claim (f) "(f) establishing one or more application patterns that are identifiable within the pictorial representation, each application pattern being indicative of a partitioning of an application logic and a data together with the styles of interaction among a plurality of logical tiers" would achieve the scope of the claimed invention which is "designing an architecture for a business solution"?

Claim Rejections - 35 USC § 112

2. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As of As of 1/9/07, independent method claim 1 is as followed:

1. (Original) A method for designing an architecture for an e-business solution, said method comprising:

(a) developing a business description of the e-business solution, the business description describing each actor and each business function in the e-business solution,

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the business description further describing each interaction among one or more actors and one or more business functions;

(b) developing a pictorial representation of the business description;

c) establishing one or more business patterns that are identifiable within the pictorial representation, each business pattern being indicative of each grouping of one or more actors and one or more business functions based on a nature of the interaction among the one or more actors and the one or more business functions;

d) establishing one or more integration patterns that are identifiable within the pictorial representation, each integration pattern being indicative of an integration of two or more business patterns;

(e) establishing one or more composite patterns that are identifiable within the pictorial representation, each composite pattern being indicative of a grouping of a recurring combination of one or more business patterns and one or more integration patterns; and

(f) establishing one or more application patterns that are identifiable within the pictorial representation, each application pattern being indicative of a partitioning of an application logic and a data together with the styles of interaction among a plurality of logical tiers.

As shown in the preamble, the claims calls for a method or a system for designing an architecture (diagram or flowchart) for a business solution (or solving a problem) and wherein the business is an e-business. Normally, when one determines a solution, one would look at what is the problem, analyzing the problem, and then design

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a solution based on the analysis. In this case, there is no discussion of a problem, no analysis of the problem and then suddenly step (a) calls for a description of the solution and the entities or parties involved and then step (b) calls for a developing a pictorial representation of the description in (a). Steps (c) –(f) are silent with respect to “designing ... solution” or there are nothing in steps (c) –(f) that deal with designing a diagram for solving a problem or obtaining a solution. It appears that the claim may deal with a method for designing an architecture (diagram or flowchart) for a business structure to do some types of service and not solving a problem or obtaining a solution.

Similarly, independent system claim 9 is rejected for the same reason set forth in claim 1 above since it has similar limitations.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over HACK et al.

As best as the examiner can understand the claimed invention, claim 1 is fairly taught by HACK et al as shown in Figs. 2A-2B, steps (a)-(b) and Figs. 3-4B and 5 "APO 3.0+, SAP Logistics 4.6B for application" for the various business patterns identifiable from the presentation (diagram or flow of Figs. 2A-2B) and col. 13, lines 3 to 67 or Figs. 9-10 for the teachings of steps (c)-(f). HACK et al fairly teaches the claimed invention except for the various patterns identifiable between the business participants based on their interactions. However, as taught on HACK et al col. 9, lines 2-50, this is a part of the value chain optimization for shifting activities and responsibilities between business participants in order to evaluate various collaborative business scenario, and therefore, it would have been obvious to carry out steps of establishing patterns as part of value chain optimization for shifting activities and responsibilities between business

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participants in order to evaluate various collaborative business scenario for now and future comparisons.

As for dep. claims 2-8 (part of 1 above) which deal which various ways for developing applications within the pictorial representation, these are fairly taught in Figs. 3, 4A and 4B.

As for dep. claim 9 (part of 1 above) which deal changing the representation by refining, this is fairly taught in col. 13, lines 50-61 "change management", col. 14, lines 14-25.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The article "Supply Chain Council & Supply Chain Operations Reference (SCOR) Model Overview" which appears to teach similar concepts to the claimed invention is cited here for applicant's awareness in the future if needed.

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8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtm
June 11, 2007


DEAN T. NGUYEN
PRIMARY EXAMINER